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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,427	01/27/2004	Robert LaFave	POL-00011	1525
7590	08/01/2005		EXAMINER	
Warn, Burgess & Hoffmann, P.C. P.O. Box 70098 Rochester Hills, MI 48307			ZACHARIA, RAMSEY E	
			ART UNIT	PAPER NUMBER
			1773	

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/765,427	LAFAVE ET AL.	
	Examiner Ramsey Zacharia	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-109 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-109 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 27 January 2004 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/29/2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Product claims 1-60 and method claims 61-109 have been examined together because claims 61-109 are directed to nominal methods. In the event that substantive method steps or limitations are added to the claims, those claims may be subject to restriction.

### ***Information Disclosure Statement***

2. The first and third references on page 5 of the IDS filed 29 March 2004 have been lined through because there are no publication dates for these references as required by 37 CFR 1.98. In the absence of publication dates, no determination can be made as to whether or not the references constitute prior art that may anticipate or render obvious the claims.

### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: **206'**, **208'**, **210'**, **212'**, **214'**, and **216'**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin

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as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-86 and 94-109 are rejected under 35 U.S.C. 102(b) as being anticipated by Grimes et al. (U.S. Patent 4,330,352).

Grimes et al. teach a laminate comprising a substrate **1**, decorative metallized layer **2**, an adhesive layer **3**, carrier layer **4**, and a release layer **5** (Figure 2 and column 2, lines 29-51). The laminate is used to apply decorations to a substrate such as a motor vehicle (column 1, lines 13-15). Because motor vehicles have curved surfaces, the application of the laminate to a motor vehicle encompasses application onto a curved surface. Substrate **1** corresponds to the polymeric

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substrate of the instant claims. Decorative metallized layer **2** corresponds to the paint or color containing film system of the instant claims. Adhesive layer **2** corresponds to the adhesive film of the instant claims. Carrier layer **4** corresponds to the support film of the instant claims. Release layer **5** corresponds to the release layer of the instant claims. The carrier layer may be stripped off the laminate, i.e. it is releasably adhered (column 2, lines 49-51). The carrier layer may be formed of polyvinyl fluoride and has a thickness of about 0.5 to 5 mils, i.e. about 0.0005 to 0.005 inches (column 2, lines 52-62).

Grimes et al. are silent with respect to the tensile strength of the carrier layer at 300 °F. However, because Grimes et al. uses the same material (polyvinyl fluoride) within the same thickness range (about 0.0005-0.005 in) as the support film of the instant invention (see paragraphs 00237 and 00238 on page 41 of the instant specification), the carrier of Grimes et al. should inherently possess the same tensile strength as the support film of the instant invention.

Regarding the second thermoformable film of claims 2, 16, 29, 41, 62, 75, 88, and 95, the limitations of these claims are met because the claims do not specify any structural relationship between the second thermoformable film and the rest of the invention. The second thermoformable film is required to releasably adhere to and support a polymeric substrate during a thermoforming process, but this is merely an intended use of the second thermoformable film. The claims are not directed to a thermoforming process, therefore the mere presence of a second film is sufficient to meet the limitations of claims 2, 16, 29, 41, 62, 75, 88, and 95. Grimes et al. meets this limitation because a second laminate of Grimes et al. would have a second carrier layer.

Regarding claims 6, 9, 19-22, 28-39, 45, 48, 55, 57, 67, 78, 81, 84, 101, and 104-109, the release layer of Grimes et al. reads on a release layer that is operable to releasably adhere to the polymeric substrate, paint or color containing film, etc. because that claims merely require the release layer to be "operable to releasably adhere." Since the release layer of Grimes et al. is not irreversibly adhered to the laminate but may be removed by means such as abrading it off, cutting it off, dissolving it off with a solvent, etc., it is releasably adhered.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes et al. (U.S. Patent 4,330,352) in view of Johnson et al. (U.S. Patent 5,518,786).

Grimes et al. teach a laminate comprising a substrate **1**, decorative metallized layer **2**, an adhesive layer **3**, carrier layer **4**, and a protective layer **5** (Figure 2 and column 2, lines 29-51). The laminate is used to apply decorations to a substrate such as a motor vehicle (column 1, lines 13-15). Because motor vehicles have curved surfaces, the application of the laminate to a motor vehicle encompasses application onto a curved surface. Substrate **1** corresponds to the polymeric substrate of the instant claims. Decorative metallized layer **2** corresponds to the paint or color containing film system of the instant claims. Adhesive layer **2** corresponds to the adhesive film of the instant claims. Carrier layer **4** corresponds to the support film of the instant claims.

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Protective layer 5 corresponds to the surfacing film system of the instant claims. The carrier layer may be stripped off the laminate, i.e. it is releasably adhered (column 2, lines 49-51). The carrier layer may be formed of polyvinyl fluoride and has a thickness of about 0.5 to 5 mils, i.e. about 0.0005 to 0.005 inches (column 2, lines 52-62).

Grimes et al. are silent with respect to the tensile strength of the carrier layer at 300 °F. However, because Grimes et al. uses the same material (polyvinyl fluoride) within the same thickness range (about 0.0005-0.005 in) as the support film of the instant invention (see paragraphs 00237 and 00238 on page 41 of the instant specification), the carrier of Grimes et al. should inherently possess the same tensile strength as the support film of the instant invention.

Regarding the second thermoformable film of claims 2, 16, 29, 41, 62, 75, 88, and 95, the limitations of these claims are met because the claims do not specify any structural relationship between the second thermoformable film and the rest of the invention. The second thermoformable film is required to releasably adhere to and support a polymeric substrate during a thermoforming process, but this is merely an intended use of the second thermoformable film. The claims are not directed to a thermoforming process, therefore the mere presence of a second film is sufficient to meet the limitations of claims 2, 16, 29, 41, 62, 75, 88, and 95. Grimes et al. meets this limitation because a second laminate of Grimes et al. would have a second carrier layer.

Grimes et al. do not teach use of a release layer that remains with the carrier layer when the carrier layer is stripped from the laminate.

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Johnson et al. is directed to a dry transfer laminate used to decorate car body members or panels (column 1, lines 11-17). Johnson et al. teach that the carrier sheet may have a silicone coated release surface or a thin film of wax (column 5, line 46-column 6, line 18).

One skilled in the art would be motivated to coat the carrier layer of Grimes et al. with a silicone or wax release coating to facilitate the removal of the carrier layer, particularly when layer 5 is a protective layer.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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